

REMARKS

Claims 1-14 are pending in the application.

Claims 1, 2 and 4-12 have been rejected.

Claim 3 and 14 have been objected to.

Claims 1 and 5-14 have been amended, as set forth herein.

New Claims 15-20 have been added.

I. **EXAMINER INTERVIEW**

Applicant thanks the Examiner for holding the in-person interview with the Applicant's representatives, Mr. Peter Lando and Mr. Terry Daglow, on October 13, 2004, and Applicant believes that the Interview Summary form provides proper recordation of the interview.

II. **OBJECTION TO THE TITLE OF THE INVENTION**

Applicant has amended the Title of the invention.

III. **OBJECTIONS TO CLAIMS 3 AND 14**

Applicant thanks the Examiner for the indication that Claims 3 and 14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. However, at this time, Applicant has chosen not to rewrite these claims in independent form.

IV. REJECTION UNDER 35 U.S.C. § 102

Claims 1, 2, 5-11 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by Martyniuk, et al. (US 5,524,338). The rejection is respectfully traversed.

A cited prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single cited prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

Applicant respectfully submits that Figures 36 and 37 of Martyniuk fails to disclose a method of forming an isodiametric lead (or an isodiametric lead structure), as arranged in Applicant's claims. Applicant has sufficiently described "isodiametric." See, Page 1, line 19 thru Page 2, line 7; Page 2, lines 21-30; Page 3, lines 16-17 and 25-28; Page 11, lines 14-18; Page 11, line 28 thru Page 12, line 3. Thus, Applicant's independent Claims 1, 5 and 9 (and their dependent Claims) have distinguished over the art.

During the interview, the Examiner raised the issue of claim language in the preamble. Applicant respectfully disagrees with the Examiner, however, to further prosecution, and as discussed during the examiner interview, Applicant has amended independent Claim 1 to recite over-molding the assembly with a first material to form an intermediate assembly, and removing at least a portion of the first material of the intermediate assembly in excess of the prescribed

diameter of the lead, where the lead comprises the at least one electrode, the at least one terminal and the lead body.

Figure 37 (and accompanying text, Col. 11, line 63 thru Col. 12, line 30) of Martyniuk illustrates a cross-sectional shape of the probe tip 300 that is not a substantially isodiametric lead. Further, the electrodes are exposed through an opening 310 by ablating the overlying dielectric layer. The removal of this dielectric material (310) is not the same as Applicant's removing of material in excess of the prescribed diameter of the lead. Moreover, Martyniuk removes the excess material to form an opening 310 to expose the electrode -- and fails to form an isodiametric lead. Therefore, Applicant's independent Claim 1 (and dependent Claims 2-4) is not anticipated by Martyniuk.

Accordingly, the Applicant respectfully requests the Examiner withdraw the § 102(b) rejection of Claims 1-2, 5-11 and 13.

V. REJECTION UNDER 35 U.S.C. § 103

Claims 4 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Martyniuk, et al. (US 5,524,338) in view of Winkler (US 5,555,618). The rejection is respectfully traversed.

For the same reasons set forth above in response to the 102 rejection, Applicant respectfully submits that none of the references, either alone or in combination, disclose, teach or suggest Applicant's invention as recited in the claims.

In addition, though Winkler recites over-extruding the outer layer 20 and using centerless grinding to grind down to a constant diameter (to mask irregularities originally present due to the presence of the wires 45 wound on the core-covering layer 44), Winkler's over-extrusion and grinding is performed prior to assembly of the electrodes/terminals and connections to a conductor. Col. 6, line 59 thru Col. 7, line 10 (and thereafter). It is therefore unclear how the combination of Winkler with Martyniuk would produce Applicant's isodiametric lead, as claimed. The centerless grinding of Winkler would not be utilized with the electrode tip portion (or microelectrode) 290 as shown in Figures 36 and 37. Centerless grinding (as recited in Applicant's claims as causing removal of material in excess of a prescribed substantially round diameter) of the electrode 290 or substrate 294 in Martyniuk would be detrimental thereby damaging or undesirably exposing the conductors, electrodes, or substrate. Thus, there is no purpose or reason that Martyniuk's electrode tip portion would be subject to, or benefit from, the centerless grinding of these portions.

Accordingly, the Applicant respectfully requests withdrawal of the § 103(a) rejection of Claims 4 and 12.

VI. CONCLUSION

As a result of the foregoing, the Applicant asserts that the remaining Claims in the Application are in condition for allowance, and respectfully requests an early allowance of such Claims.

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *rmccutcheon@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Davis Munck Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date: 1/18/2005



Robert D. McCutcheon
Registration No. 38,717

P.O. Box 802432
Dallas, Texas 75380
(972) 628-3632 (direct dial)
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *rmccutcheon@davismunck.com*